

AMENDMENTS TO THE DRAWINGS

By this Amendment Application has amended Figs. 4 and 5 to schematically depict the stop as supported throughout the application, for example at paragraphs 0019, 0037 and 0080 as published. No new matter is added.

REMARKS

Claims 23, 25, 27-45 and 47 are pending. By this Amendment, no claims are cancelled, claim 23 is amended and no new claims are added.

Drawings

The Office Action maintained objections to the drawings indicating that the stop as depicted in Fig. 9 is not labeled with element numbers nor is it described as a stop. Applicant respectfully traverses the objection. There is no legal requirement in the statute that any structure be labeled with a reference number nor that a structure have *in haec verba* support in the specification. The Office Action cites no law in support of the Examiner's position. While Fig. 12 may be a graph that does not depict structures of the stop the function of the stop graphically depicted in Fig. 12 as should be readily apparent to one of ordinary skill in the art. Applicant has not argued that Fig. 12 depicts the stop. Instead Applicants have argued that the graph represents the action of the claimed stop.

Further still, solely to advance prosecution Applicant has amended Figs. 4 and 5, without adding new matter, to schematically depict the stop as supported throughout the application, for example in paragraphs 0019, 0037 and 0080. No new matter has been added. Applicant respectfully requests that the Examiner withdraw the objection. This is discussed further below.

35 U.S.C. § 112

112 First Paragraph

The Office Action rejected claims 23, 25, 27, 28 and 45 under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. Applicants respectfully traverse the rejection but solely to advance prosecution, by this amendment, Applicants have amended claims 23 to recite the limitations:

further wherein the safety mechanism comprises a stop of the housing and a holding element to which the contact glass is mounted, wherein the holding element is pressed against the stop of the housing by a force defining the limit value of force.

These limitations are supported throughout the application, for example, in nearly identical words in paragraph 0019 of the application as published. Therefore, there can be no argument that the application lacks written description for these limitations. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

Further, Applicants respectfully traverse the rejection at least because the examiner failed to establish a *prima facie* case of lack of written description and because the invention as currently recited in claim 23 is described in the specification and drawings of the application as originally filed.

The fundamental inquiry under 35 U.S.C. § 112, first paragraph is “whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” MPEP § 2163(I)(B) (citing Vas-Cath, Inc. v. Marhurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)). “[I]nformation

contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” (MPEP § 2163.06). In other words, claims can be amended to recited information contained in the original specification or drawings without adding new matter.

“The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (MPEP § 2163.04 (citing In re Wertheim, 541 F.3d 252, 263 (CCPA 1976).) “If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the claims.” (MPEP § 2163(II)(A).)

In the Office Action, the Examiner failed to present any evidence that one skilled in the art would not recognize the invention recited in claim 23 in the disclosure. In particular, the Examiner did not set forth any “express finding of fact which supports the lack of description conclusion” necessary to establish a *prima facie* case of lack of written description. (MPEP § 2163.04(I)(A).) Therefore, claim 23 as amended is allowable.

112 Second Paragraph

The Office Action also rejected claim 23 and its dependent claims under 35 U.S.C. § 112 second paragraph as being incomplete for omitting essential structural cooperative relationships of elements. Applicant respectfully traverses the rejection. According to section 112: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter *which the applicant regards as his invention*. Emphasis added. It is *the Applicant* who is granted the right to claim the subject matter which he regards as his invention. Therefore, it is the Applicant who decides which structural relationships are to be recited in the claims.

The Office Action further asserts that “[t]he specification lacks support for this relationship as there is no single drawing where all of these elements are shown cooperating together in the claimed manner.” Applicant traverses the assertion and the rejection. The Office Action cites no law in support of this assertion. There is no legal requirement that the application contain a “single drawing where all of these elements are shown cooperating together in the claimed manner.” The statute, at 35 U.S.C. 113, states only that “[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” 37 CFR 1.83 states that the drawings “must show every feature of the invention specified in the claims.” As has been explained in a prior amendment, the drawings originally filed show every feature of the claimed invention.

There is no requirement in the statute that each element in the claims be identified by reference numerals. Nonetheless for the Examiner's convenience and to advance prosecution applicant has amended the drawings and specification to reflect the stop as described in the application as originally filed.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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